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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,776	04/13/2006	Masahiro Yoshioka	0760-0353PUS1	3792

2292 7590 12/12/2008  
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PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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PAK, HANNAH J

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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12/12/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,776	<b>Applicant(s)</b> YOSHIOKA ET AL.	
	<b>Examiner</b> Hannah Pak	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/12/2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicants' amendment filed on 09/12/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 8-16, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) in view of Bertram (US 4,162,244).

The rejection is adequately set forth in pages 4-5 of Office action mailed on 09/12/2008 and is incorporated here by reference.

5. Claims 5-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) in view of Bertram (US

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4,162,244) as applied to claims 1-4, 8-16, and 19-22 above, and further in view of Hedaya et al. (US 4,208,492).

The rejection is adequately set forth in pages 4-5 of Office action mailed on 09/12/2008 and is incorporated here by reference.

### ***Response to Arguments***

6. Applicants' arguments filed 09/12/2008 have been fully considered but they are not persuasive. Specifically, the applicants appear to argue that **A)** Tsukamoto et al. fail to disclose a basis for one skilled in the art to select appropriate components in order to satisfy Equations (3) and (4) so as to obtain the black composition (see Page 9 of the Applicants' Remarks). The applicants further argue that **B)** even if Tsukamoto et al. is properly cited as a basis for asserting prima facie obviousness, such obviousness has been rebutted by the evidence of unexpected advantageous properties described in the present specification (see Page 9 of the Applicants' Remarks). In support of this argument, the applicants refer to of the descriptions of the examples of the present specification (see pages 8-9 of the Applicants' Remarks).

With respect to the argument **A)**, as indicated in the earlier office action filed (see page 2), Tsukamoto et al. disclose a black coating composition containing titanitic acid nitrides or titanium black (titanium nitride oxide), a solvent, and a resin, useful for making black matrices and liquid crystal display with excellent high light blocking effect and high volume resistance (Paragraphs 11, 21 and 50), which may also comprise.

"Various additives, including carbon black (Paragraph 9) and have the X-ray intensity ratio R having the formula below (Paragraphs 11-12):

$$R = I_3 / \{I_3 + 1.8 \times (I_1 + 1.8 \times I_2)\};$$

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wherein  $R$  is 0.28 or more,  $I_1$  represents the maximum diffraction line intensity of the titanitic acid nitrides when the angle of diffraction  $2\theta$ , determined by using a X line source CuK alpha rays, is 25-26 degrees,  $I_2$  represents the maximum diffraction line intensity of the titanitic acid nitrides when the angle of diffraction  $2\theta$  is 27-28 degrees, and  $I_3$  represents the maximum diffraction intensity of the titanitic acid nitrides when the angle of diffraction  $2\theta$  is 36-38 degrees. As is apparent from the above,  $R$  corresponds to the claimed  $R_1$  and embraces a value inclusive of the claimed  $R_1$  value.  $I_3$  is identical to the claimed  $I_3$ .  $I_1$  and  $I_2$  values, therefore, necessarily overlap with the claimed  $I_1$  and  $I_2$  values, i.e., the claimed  $R_2$  value, to arrive at the  $R$  value of 0.28 or more," see also MPEP § 2144.05.

As shown above, Tsukamoto et al. do disclose a basis for one skilled in the art to select appropriate components in order to satisfy the claimed Equations (3) and (4) so as to obtain the black composition with advantageous properties.

With respect to argument **B)**, the description speculated in the specification are not supported by any objective evidence. Applicants have not shown that the claimed  $R_1$  and  $R_2$  ranges from equations (3) and (4) impart unexpected results relative to the exemplified embodiment of Tsukamoto et al. Accordingly, "the law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range," see MPEP § 2144.05: *REBUTTAL OF PRIMA FACIE CASE OF OBVIOUSNESS*. Mere statement is not sufficient as objective evidence.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak  
Examiner  
Art Unit 1796

/HP/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796